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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAN KIKINIS

Appeal 2008-005420
Application 09/911,945
Technology Center 2400

Decided: November 13, 2009

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
THU A. DANG, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 8-10, 13, and 14. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

The invention at issue on appeal is a data delivery system which comprises a server connected to data sources and adapted to transmit data to a user; a first link from the server adapted to transmit data to the user via a first delivery path; a second link from the server adapted to transmit data via a second delivery path to the user, the second delivery path having a broader bandwidth than the first delivery path; and transmission control routines. For each data entity to be transmitted to the user, the transmission control routines select either the first path or the second path for transmission, based on size of the data entity and preprogrammed criteria. (Spec. 4.)

B. ILLUSTRATIVE CLAIM

Claim 8, which further illustrates the invention, follows.

8. A broadband data transmission system comprising:

a high priority queue reserved for data entities requiring that data entities be transmitted in a successive fashion at or above a minimum rate to insure no interruptions;

a lower priority data entity queue; and

control routines adapted for dividing large data entities in the lower priority queue into multiple smaller data entities of a size that may be interspersed with the transmission of data entities from the high priority queue without causing the rate of transmission of the high priority entities to fall below the minimum rate.

C. REFERENCES

The Examiner relies on the following references as evidence:

Mendelson	US 5,754,783	May 19, 1998
Liebowitz	US 5,812,545	Sep. 22, 1998

D. REJECTIONS

Claims 8, 9, and 13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Mendelson.

Claims 10 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mendelson in view of Liebowitz.

II. ISSUE

Has Appellant has shown error in the Examiner's initial showing of anticipation of independent claims 8 and 13, and dependent claim 9? Has Appellant shown error in the Examiner's initial showing of obviousness of dependent claims 10 and 14?

III. PRINCIPLES OF LAW

35 U.S.C. § 102

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim" *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates

anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Appellant has the opportunity on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 415, and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415-16 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 417.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 550 U.S. at 418).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

IV. ANALYSIS

At the outset, we note that Appellant expresses concern that when the teachings of the reference do not relate exactly to the claimed invention some explanation from the Examiner is necessary to explain how the Examiner believes the teachings are related. (App. Br. 6). This is a petitionable matter which is not before the Board. (MPEP 1004 "All unusual questions of practice may be referred to the Technology Center Directors.") Furthermore, Appellant's arguments do not identify whether Appellant is addressing the language of independent claim 8 or the language of independent claim 13. A majority of Appellant's arguments seem to meld facets of both independent claims 8 and 13 together. Such arguments are not persuasive to either claim 8 or 13.

We also note that a majority of Appellant's arguments are not commensurate in scope with the express language of independent claims 8 and 13, wherein the language of the claims is drafted with respect to "entities" and Appellant's arguments are specifically drafted with respect to "packets" which are not necessarily synonymous. Hence, we find Appellant's arguments to not be based on the express claim language in dispute.

Appellant contends that "Appellant's invention is not limited by software and takes place at the level of actual packet transmission on the network, not inside the compression step, as in Mendelson." (App. Br. 6-7). We find Appellant's argument unpersuasive of error since the language of independent claim 8 does not expressly set forth that the invention "takes place at the level of actual packet transmission" *id.*, nor does it set forth a specific step in a process with which to distinguish the teachings of

Mendelson. Therefore, Appellant's argument is not persuasive of the error in the Examiner's initial showing of anticipation.

Appellant argues that "Mendelson does not deal with the problem of the need to send additional real data to a user interspersed in a broadband transmission requiring minimum bandwidth so transmission is not interrupted." (App. Br. 7). Appellant argues a specific situation in Mendelson where passing packets are filtered out and replaced with content of a limited size and type related to the video content as shown in Figures 1 and 3 of Mendelson, but in the event that content is not available to fill the space left from removing the padding packets, additional padding packets are provided instead. Appellant contrasts the invention where dividing the second data entity into multiple portions each portion is small enough to insure that it may be transmitted interspersed with data entities without violating the minimum rate for the first data entities. (App. Br. 7). We note that Appellant's argument is not based upon the express language of either independent claims 8 or 13. Therefore, Appellant's argument is not persuasive of the error in the Examiner's initial showing of anticipation.

Appellant describes the functioning of Mendelson with regard to the incoming MPEG video stream in Figure 4 and further contends that Mendelson does not "resize data packets from a lower priority queue to insert in a data stream from a higher priority queue in order to send needed data to a user receiving the data stream from the higher priority queue." (App. Br. 7-8). Again, Appellant's argument is based upon a melding of the two independent claims where independent claim 13 does not recite resizing data packets or a lower priority queue and independent claim 8 does not

recite resizing data packets or needed data to a user receiving the data stream.

Appellant identifies that the Specification identifies the present invention as an alternative to compression because compression of files costs a user in terms of money and time spent to install and operate software applications. Appellant contends that the claimed system transmits autonomous packets of data resides to a specific size available in between transmission bursts of time sensitive data (video) in a manner as to not disrupt the transmission of the time sensitive data. Appellant contends in contrast to Mendelson, Appellant's invention can be used with any type of data of any size and can be sent because it is not inserted within the video contact packets as in Mendelson. (App. Br. 8). Again, Appellant's contention is not based upon an express language of independent claims 8 or 13 and does not show error in the Examiner's initial showing of anticipation.

Appellant argues that Mendelson is limited as to
type of data and the size is restricted to the size of the padding packets as originally received in the MPEG. Further, appellant argues that the secondary content cannot be autonomous from the primary content because Mendelson does not teach a facility at the receiver's end for filtering out the secondary content.

(App. Br. 8).

We find no relevance in Appellant's argument to the invention as expressly recited in independent claims 8 and 13. Nor has Appellant identified any express relevance to any express limitation in these claims. Therefore, Appellant's argument is not persuasive of error in the Examiner's initial showing of anticipation.

Appellant argues that Mendelson actually pads packets containing video contact and does not resize existing packets to fit in the satellite transmission, as claim. (App. Br. 8). We find Appellant's argument is not commensurate with the invention as recited in independent claims 8 and 13. Therefore, Appellant's argument is not persuasive of error in the Examiner's initial showing of anticipation.

Appellant identifies an embodiment of the disclosed invention where packets of a size large enough to cause an interruption are divided into packets small enough to be sent in between bursts and that the dividing factor for the size is determined by factors such as the capacity of a satellite link in the time that may be available for transmission between video packet transmissions. (App. Br. 8). Appellant then contends that Mendelson can never send a large file in need of resizing because the PCR (program clock reference) limitations of the original received in MPEG video stream only allow secondary data of a size equaling differences between the VBR and CBR, and packets are created and generated for this specific size, existing packets are not resized. (App. Br. 9). Again, Appellant's argument is based upon a comparison of the disclosed invention rather than a comparison to the invention as recited in the express language of independent claims 8 and 13. Therefore, Appellant's argument is not persuasive of error in the Examiner's initial showing of anticipation. Since Appellant has not shown any error in the Examiner's initial showing, we will sustain the rejection of independent claim 8. We will group independent claim 13 and dependent claim 9 as falling with independent claim 8 since Appellant has not set forth separate arguments for patentability.

With respect to dependent claims 10 and 14, Appellant contends that "Appellant's specification clearly recites . . ." and then Appellant contends that the "103 rejection regarding Liebowitz fails as Mendelson does not resize packets, therefore needing a key." (App. Br. 10). Appellant contends that there is absolutely no motivation in the part provided by the Examiner to provide a deficiency because there is no need in Mendelson to reassemble resized padding packets at the receiver and added that the reasoning for the combination cannot be made in this case without the Examiner's hindsight knowledge of the teachings of Appellant's invention and therefore the obviousness rejection must fail. (App. Br. 10). We disagree with Appellant and find that Appellant's argument is based upon Appellant's comparison of the combination of Mendelson and Liebowitz with Appellant's disclosed invention rather than the invention as recited in dependent claims 10 and 14 as they depend from independent claims 8 and 13. Therefore, we find Appellant's arguments to be unpersuasive of error in the Examiner's initial showing of obviousness. Accordingly, we will sustain the Examiner's rejection of dependent claim 10 and will group dependent claim 14 with claim 10 since Appellant has not set forth separate arguments for patentability.

V. CONCLUSION

For the aforementioned reasons, Appellant has not shown error in the Examiner's initial showing of anticipation of independent claim 8, and Appellant has not shown error in the Examiner's initial showing of obviousness of dependent claim 10.

VI. ORDER

We affirm the anticipation rejection of claims 8, 9, and 13, and the obviousness rejection of claims 10 and 14.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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